

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

F7764(V)

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on _____

Signature _____

Typed or printed name _____

Application Number

10/590,645

Filed

August 25, 2006

First Named Inventor

Veldhuizen

Art Unit

1789

Examiner

Thuy Tran Lien

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Gerard J. McGowan, Jr./

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Signature

Gerard J. McGowan, Jr.

Typed or printed name

☒ attorney or agent of record.
Registration number 29,412

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Telephone number

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

12-20-2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Attorney Docket No.: F7764(V)
Serial No.: 10/590,645
Filed: August 25, 2006
Confirmation No.: 1494

REMARKS

Sir:

Reconsideration of the application is respectfully requested in view of the following remarks.

The Commissioner is hereby authorized to charge any additional fees, which may be required to our deposit account No. 12-1155, including all required fees under: 37 C.F.R. §1.16; 37 C.F.R. §1.17; 37 C.F.R. §1.18; 37 C.F.R. §1.136.

The application is directed to a bakery product which includes flour and from 0.5 to 15 wt% on flour of sterol and/or stanol fatty acid ester and from 0.1 to 1 wt% of emulsifier on flour, wherein the emulsifier is selected from a recited group and a combination thereof. It is important to note that the amount of the sterol and the amount of the emulsifier are given on flour.

Although Yuan et al., US Patent No. 6, 190,720 mentions baked goods, the Office points to no mention by Yuan et al. of levels of flour in any of its baked goods. The Office appears to rely on the inherency of the level of flour with respect to sterol and emulsifier in the Yuan patent. However, even if it were reasonable to say that the recited levels of sterol and emulsifier on flour could be present in Yuan et al., the fact that a certain result or characteristic may be present in the prior art is not sufficient to establish the inherency of that result or characteristic. MPEP §2112 IV. To establish inherency, the intrinsic evidence must make clear that the missing descriptive matter is

necessarily present in the thing described in the reference. Inherency may not be established by probabilities or possibilities.

The Office points to Yuan et al. as teaching that sterol esters comprise up to about 90% of their ingredient and that their ingredient comprises up to 20% of a food. Taking as an example the upper ends of these ranges, then, sterol would comprise about 18% of the food. Applicants' claim 1 recites 0.5 to 15 wt% on flour of sterol and/or sterol fatty acid ester. If sterol is 18% of the product it hardly seems likely that it could be 15% of the flour. It is apparent from this example that it is not inevitable that the parameters of the present claims would be satisfied by Yuan et al.

The Office argues that since the claims do not specify any other ingredients of the food, the amount based in the food composition is equivalent to the amount based in flour. It is submitted that to find inherency the Office needs to find the recited invention in the one reference and that if the claim recites wt% in flour the Office cannot ignore other ingredients which it is taught may be present in the food of the reference. Again, inherency is not established by probabilities or possibilities.

In view of the foregoing, it is respectfully requested that the application, as amended, be allowed.

Respectfully submitted,

/Gerard J. McGowan, Jr./

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